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EXAMINER

HIGHTER, TREVILLIAN H

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/815,901	HARIK ET AL.	
	Examiner	Art Unit	
	TREVILLIAN H. HIGHTER	4152	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/31/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-49 are pending in this application

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-15 and 18-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzpatrick et al. (Patent No. US 7,266,583 B2), hereinafter **Fitzpatrick**.

4. With respect to claim 1, Fitzpatrick discloses an IM server (column 9, lines 52-55; abstract, lines 22-24) connected to a communication network (column 6, lines 52-54; Fig. 1 displays a server connected to a network); and logic operable on the IM server enabling a first user to browse contacts associated with a second user (column 1, lines 17-21 and 51-56; abstract, lines 22-24).

5. With respect to claim 2, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54).

6. With respect to claim 3, Fitzpatrick discloses the logic additionally enables the first user to add and list contacts accessed by browsing the contacts associated with the second user (column 8, lines 11-16, chat session participant 300 of contact list 310 is considered the first user and the contact list 110 is considered as belonging to the second user).

7. With respect to claim 4, Fitzpatrick discloses the second user groups contacts in distinct separate lists (column 4, lines 48-53), and the first user is enabled to browse contacts in only the second user's list that includes the first user as a contact (column 2, lines 36-38; column 4, lines 66-67; column 5, lines 1-8).

8. With respect to claim 5, Fitzpatrick discloses a means operable for the second user to enable and disable access by the first user to individual ones or lists of contacts associated with the second user (column 9, lines 11-13; column 2, lines 58-65).

9. With respect to claim 6, Fitzpatrick discloses a means for the first user to select a screen name from the contacts of the second user (column 6, lines 59-66), which selection adds the selected screen name as a contact for the first user (column 8, lines 7-16).

10. With respect to claim 7, Fitzpatrick discloses the means for a user to select a screen name is an interactive list (column 6, lines 59-66) displayed to the first user on a display screen (column 6, lines 59-66) of a first computerized appliance connected to the IM network (column 9, lines 64-67; column 10, lines 1-3) and executing a first instance of client logic of the IM system (column 8, lines 7-16; abstract, lines 22-24).

11. With respect to claim 8, Fitzpatrick discloses the second user's contacts are stored and displayed on a second computerized appliance (column 9, lines 64-67; column 10, lines 1-3) executing a second instance of client logic of the IM system (column 8, lines 7-16; abstract, lines 22-24).

12. With respect to claim 9, Fitzpatrick discloses upon the first user selecting a screen name from the contact list of the second instance (column 8, lines 7-14), the second instance sends a message to a third instance of the IM client on the network (column 10, lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second instance is inherent; column 11, lines 33-34; abstract, lines 22-24), the third instance registered to a person using the selected screen name (column 7, lines 23-28), the message alerting the person using the selected screen name that the first user is adding his name to the first user's contact list (column 11, lines 33-37).

13. With respect to claim 10, Fitzpatrick discloses the second instance, upon the first user selecting a name from the contact of the second instance (column 8, lines 7-14), acts as an intermediary, sending at least a message to a third instance of the IM client (column 10, lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second instance is inherent; column 11, lines 33-34; abstract, lines 22-24) registered to the person using the selected screen name (column 7, lines 23-28), the message seeking approval for addition of the selected screen name to the contact list of the first instance (column 11, lines 33-37).

14. With respect to claim 11, Fitzpatrick discloses the second instance, upon the first user selecting a screen name from the contact list of the second instance (column 10, lines 64-67; column 11, lines 1-2, first user is considered as user #3, second instance is considered user #1), sends messages (column 11, lines 10-12, second instance is considered user #1) to both the third instance registered to the person using the selected screen name (column 11, lines 33-34; column 7, lines 23-28) and also to the first user at the first instance (column 11, lines 33-34), providing introductory information (column 11, lines 15-24) to each of the two users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) about the other of the two users (column 11, lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

15. With respect to claim 12, Fitzpatrick discloses the two messages sent (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) also seek response from the two users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, 34-37).

16. With respect to claim 13, Fitzpatrick discloses a repository storing profile information about individual users (column 1, lines 27-36, when storing information in a file, a repository is inherent); and a description-based search means (column 1, lines 37-42) executable by users to search the repository for one or more other users based on search criteria entered by the searching user (column 1, lines 37-42).

17. With respect to claim 14, Fitzpatrick discloses the search is conducted without regard to a field (column 1, lines 37-42, user identifier is considered to be an icon).

18. With respect to claim 15, Fitzpatrick discloses the search is performed on a keystroke by keystroke basis (column 1, lines 37-42, profile information can be acquired by the text typed by a user, therefore, a search performed by keystroke basis is inherent).

19. With respect to claim 18, Fitzpatrick discloses receiving a field-independent search query (column 1, lines 37-42); and performing a search of stored user profile information using the query (column 1, lines 37-42).

20. With respect to claim 19, Fitzpatrick discloses a further action for providing contact information resulting from the search to a user initiating the search query (column 1, lines 37-42).

21. With respect to claim 20, Fitzpatrick discloses providing at least first and second instances of an IM client (column 1, lines 51-56; abstract 22-24) on first and second computerized appliances respectively on a network (column 9, lines 64-67; column 10, lines 1-3); and providing a browsing means in the first instance of the IM client (column 1, lines 17-21) to allow browsing screen names in a contact list of the second instance by a first user of the first instance (column 7, lines 6-8, when viewing contact list 110 of the first instance by chat session participant 300, a third user of the instance, browsing screen names by a first user of the first instance is inherent).

22. With respect to claim 21, Fitzpatrick discloses initiating the browsing function by selecting one of a menu line item or an interactive icon (column 6, lines 59-61) in an interactive interface on a display screen (column 6, lines 59-66) one of the computerized appliances (column 9, lines 64-67; column 10, lines 1-3).

23. With respect to claim 22, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54) and one or more of the computerized appliances are personal computers connected to the Internet (column 9, lines 64-67; column 10, lines 1-3; Fig. 1, users are connected to the Internet; column 6, lines 52-54).

24. With respect to claim 23, Fitzpatrick discloses a user of the second instance enabling or disabling access by the browsing user of the first instance (column 1, lines 51-56 and 67; column 2, lines 1-2) for individual ones or groups of contacts in contact lists of the second instance (column 1, lines 51-56).

25. With respect to claim 24, Fitzpatrick discloses selecting a screen name from the contact list of the second instance (column 8, lines 7-14), which adds the selected screen name as a contact in the contact list of the first instance (column 8, lines 7-16).

26. With respect to claim 25, Fitzpatrick discloses displaying an interactive list of contacts (column 6, lines 59-66) from a contact list of the second instance (column 8, lines 7-14) in a display window (column 6, lines 59-66) of the first computerized appliance (column 9, lines 64-67; column 10, lines 1-3).

27. With respect to claim 26, Fitzpatrick discloses upon the first user selecting a name from the contact list of the second instance (column 8, lines 7-14), sending a message (column 10, lines 56-64) to a third instance of the IM client on the network

(column 11, lines 33-34; abstract, 22-24), the third instance registered to the person using the selected screen name (column 7, lines 23-28), the message alerting the person using the selected screen name that the first user is adding his name to the first user's contact list (column 11, lines 33-37).

28. With respect to claim 27, Fitzpatrick discloses upon the first user selecting a name from the contact of the second instance (column 8, lines 7-14), acting as an intermediary, sending at least a message (column 10, lines 56-64) to a third instance of the IM client (column 11, lines 33-34; abstract, 22-24) registered to the person using the selected screen name (column 7, lines 23-28), the message seeking approval for addition of the selected screen name to the contact list of the first instance (column 11, lines 33-37).

29. With respect to claim 28, Fitzpatrick discloses upon the first user selecting a screen name from the contact list of the second instance (column 8, lines 7-14), sending messages (column 10, lines 56-64) to both the third instance (column 11, lines 33-34; abstract, 22-24) registered to the person using the selected screen name (column 7, lines 23-28), and also to the first user at the first instance (column 11, lines 33-34; abstract, 22-24; column 7, lines 23-28), providing introductory information (column 11, lines 15-24) to each of the two users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) about the other of the two users (column 11,

lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

30. With respect to claim 29, Fitzpatrick discloses the two messages sent (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) also seek response from the two users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, lines 34-37).

31. With respect to claim 30, Fitzpatrick discloses providing network communication between a first and second user such that each is listed by the other as a contact (column 10, lines 62-67; column 11, lines 1-10); and making other contacts of the first user available for selection by the second user (column 4, lines 56-49) for addition to the second user's contact list (column 5, lines 33-40).

32. With respect to claim 31, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54).

33. With respect to claim 32, Fitzpatrick discloses the second user groups contacts in distinct separate lists (column 4, lines 48-53), and the first user is enabled to browse

contacts in only the second user's list that includes the first user as a contact (column 2, lines 36-38; column 4, lines 66-67; column 5, lines 1-8).

34. With respect to claim 33, Fitzpatrick discloses the second user enabling and disabling access by the first user to individual ones or lists of contacts associated with the second user (column 9, lines 11-13; column 2, lines 58-65).

35. With respect to claim 34, Fitzpatrick discloses the first user selecting a screen name from the contacts of the second user (column 8, lines 7-14), which selection adds the selected screen name as a contact for the first user (column 8, lines 7-16).

36. With respect to claim 35, Fitzpatrick discloses the second user selects a screen name from the contact list of the first user (column 8, lines 7-14), and the first user causes a message to be sent to a third user (column 10, lines 56-64; column 11, lines 33-34), the third user being the person using the selected screen name (column 7, lines 23-28), the message alerting the third user that the second user is adding the third user to the second user's contact list (column 11, lines 33-37).

37. With respect to claim 36, Fitzpatrick discloses the first user, upon the second user selecting a name from the contact of the first user (column 8, lines 7-14), acts as an intermediary, sending at least a message (column 10, lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second

instance is inherent; column 11, lines 33-34) to a third user being the person using the selected screen name (column 7, lines 23-28), the message seeking approval for addition of the selected screen name to the contact list of the second user (column 11, lines 33-37).

38. With respect to claim 37, Fitzpatrick discloses the first user, upon the second user selecting a screen name from the contact list of the first user (column 8, lines 7-14), sends messages (column 10, lines 56-64) to both the third user (column 11, lines 33-34; abstract, 22-24), being the person using the selected screen name (column 7, lines 23-28), and also to the second user (column 11, lines 33-34; abstract, 22-24, column 7, lines 23-28) providing introductory information (column 11, lines 15-24) to each of the second and third users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) about the other of the second and third users (column 11, lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

39. With respect to claim 38, Fitzpatrick discloses the messages sent (column 11, lines 33-34) also seek response from the second and third users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, lines 34-37).

40. With respect to claim 39, Fitzpatrick discloses receiving a field-independent search query (column 1, lines 37-42); and performing a search of stored user profile information using the query (column 1, lines 37-42).

41. With respect to claim 40, Fitzpatrick discloses a further action for providing contact information resulting from the search to a user initiating the search query (column 1, lines 37-42).

42. With respect to claim 41, Fitzpatrick discloses providing network communication between a first and second user such that each is listed by the other as a contact (column 10, lines 62-67; column 11, lines 1-10); and making other contacts of the first user available for selection by the second user (column 4, lines 56-59) for addition to the second user's contact list (column 5, lines 33-40).

43. With respect to claim 42, Fitzpatrick discloses the network is the Internet network (column 6, lines 52-54).

44. With respect to claim 43, Fitzpatrick discloses the second user groups contacts in distinct separate lists (column 4, lines 48-53), and the first user is enabled to browse contacts in only the second user's list that includes the first user as a contact (column 2, lines 36-38; column 4, lines 66-67; column 5, lines 1-8).

45. With respect to claim 44, Fitzpatrick discloses the second user enabling and disabling access by the first user to individual ones or lists of contacts associated with the second user (column 9, lines 11-13; column 2, lines 58-65).

46. With respect to claim 45, Fitzpatrick discloses the first user selecting a screen name from the contacts of the second user (column 8, lines 7-14), which selection adds the selected screen name as a contact for the first user (column 8, lines 7-16).

47. With respect to claim 46, Fitzpatrick discloses the second user selects a screen name from the contact list of the first user (column 8, lines 7-14), and the first user causes a message to be sent to a third user (column 10, lines 56-64; column 11, lines 33-34), the third user being the person using the selected screen name (column 7, lines 23-28), the message alerting the third user that the second user is adding the third user to the second user's contact list (column 11, lines 33-37).

48. With respect to claim 47, Fitzpatrick discloses the first user, upon the second user selecting a name from the contact of the first user (column 8, lines 7-14), acts as an intermediary, sending at least a message (column 10, lines 56-64, when a token of introduction can be originated by a first participant, a message sent by a second instance is inherent; column 11, lines 33-34) to a third user being the person using the selected screen name (column 7, lines 23-28), the message seeking approval for

addition of the selected screen name to the contact list of the second user (column 11, lines 33-37).

49. With respect to claim 48, Fitzpatrick discloses the first user, upon the second user selecting a screen name from the contact list of the first user (column 8, lines 7-14), sends messages (column 10, lines 56-64) to both the third user (column 11, lines 33-34; abstract, 22-24), being the person using the selected screen name (column 7, lines 23-28), and also to the second user (column 11, lines 33-34; abstract, 22-24, column 7, lines 23-28) providing introductory information (column 11, lines 15-24) to each of the second and third users (column 11, lines 33-34, when a token of introduction is provided to one chat session participant, providing a token of introduction to more than one participant is inherent) about the other of the second and third users (column 11, lines 15-24, when a token of introduction is created, GUI fields may contain information about the users).

50. With respect to claim 49, Fitzpatrick discloses the messages sent (column 11, lines 33-34) also seek response from the second and third users granting or withholding authorization (column 11, lines 33-34) for the addition of each user's screen name to the other user's contact list (column 11, lines 34-37).

Claim Rejections - 35 USC § 103

51. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

52. **Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzpatrick, in view of Evans et al. (Patent No. 6,690,918 B2), hereinafter, Evans.**

53. With respect to claim 16, Fitzpatrick does not disclose the search criteria is imported user information. Evans however discloses the search criteria is imported user information (column 7, lines 27-30). Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Fitzpatrick by incorporating a repository and description-based search means with imported information is search criteria, in order to optimize the networking experience for users operating hand-held devices.

54. With respect to claim 17, Fitzpatrick does not disclose the imported information is a telephone number or a digital address imported from a cellular telephone or a personal digital assistant. Evans however discloses the imported information is a telephone number or a digital address imported from a cellular telephone or a persona

digital assistant (column 7, lines 27-30, when uploading profile information through a cell phone, imported information such as a phone number would be inherent).

Therefore, it would have obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Fitzpatrick by incorporating a repository and description-based search means with information imported from a cellular telephone or personal digital assistant, in order to optimize the networking experience for users operating hand-held devices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TREVILLIAN H. HIGHTER whose telephone number is (571)270-3806. The examiner can normally be reached on Monday-Thursday 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nabil El-Hady can be reached on (571) 272-3963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

THH 1/3/2008

/Nabil El-Hady, Ph.D, M.B.A./
Supervisory Patent Examiner, Art Unit 4152